

Attorney's Docket: 1999DE122
Serial No.: 09/578,421
Group: 1714

REMARKS

The Office Action mailed November 10, 2004, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 1-19 are pending in this Application. By this Amendment, Applicants have amended claims 1 through 6, 12 and 13 and have canceled claims 14-19. Thus, the claims under consideration are believed to include claims 1-14.

Elections/Restrictions

The Office has restricted the application to one of the following inventions under 35 USC § 121:

- I. Claims 1-14, drawn to a process for the production of (metal) salts of alkylphosphonous acids, classified in class 562, subclass 8; and
- II. Claims 15-19, drawn to the use of a (metal) salt of an alkylphosphonous acid, classified in class 252, subclass 609.

For prosecution in this case, Applicants elect Group I, claims 1-14, without traverse. Claims 15-19 have been cancelled without prejudice to filing a divisional application.

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Priority

The Office acknowledges Applicants' claim for foreign priority based on an application filed in Germany on May 25, 1999. The Office noted that Applicants have not filed a certified copy of the German application as required under 35 USC § 119(b). The certified copy of the application is being filed on the same date as the mailing of this Amendment under a separate cover.

Claim Rejections Under 35 USC § 112, Second Paragraph

The Office rejects claims 4 and 5, stating that the limitation "wherein the organic solvents employed are/is . . ." lacks insufficient antecedent basis. Claims 4 and 5 have been amended, changing their dependence from claim 1 to claim 2 to thereby provide antecedent basis for the phrase. The phrase has been further amended to recite "at least one organic solvent." In view of the above, it is respectfully contended that the 35 USC § 112, second paragraph rejection has been overcome.

Claim Rejection under 35 USC § 103

Claims 1-2, 4, 6-9 and 11-14 stand rejected under 35 USC § 103(a) as being unpatentable over the article entitled "Superbase-Induced Generation of Phosphide and Phosphinite Ions As Applied In Organic Synthesis". This rejection is respectfully traversed.

As claimed, Applicants' invention is directed to a process for the preparation of metal salts of alkylphosphonous acids. The process includes reacting elemental yellow phosphorous with halogen free alkylating agents in the presents of at least one base.

The article cited by the Office discloses a method for the production of triorganylphosphines and -phosphine oxides. The method includes reacting red phosphorous (or white) with organyl halides, alkenes and acetylenes in a super basic system.

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The Office takes the position that "applicants' claimed process is so broad in scope that it is deemed to encompass the production of the products taught by the reference in addition to the production of the alkylphosphonous acid salts."

Applicants can not agree.

It is Applicants' courteous position that the Office has not carried its burden of establishing a *prima facie* case of obviousness of the present claims over the cited article. It is beyond contention that a *prima facie* case of obviousness requires the prior art to provide some suggestion of motivation to one with ordinary skill in the art to modify the reference(s) and thus arrive at the claimed invention. Furthermore, a finding of obviousness requires the prior art reference to teach each and every aspect of the claimed invention. Neither the requisite motivation nor all of the claimed elements are found in the cited article.

As discussed above, the article discloses the formation of triorganylphosphines and – phosphine oxides. This article provides no motivation for one with ordinary skill in the art to conclude that the reaction disclosed by the article is capable of producing a metal salt of alkylphosphonous acid. Specifically, Applicants' claimed process yields a separate and distinct chemical compound than that of the triorganylphosphine and phosphine oxides detailed in the article.

Furthermore, Applicants' process is directed to the use of halogen free alkylating agents. The only alkylating agent disclosed by the article is an organyl halides. The alkenes and acetylenes, do not read upon the limitation of a halogen-free alkylating agent. Moreover, the halide disclosed by the cited document is excluded by Applicants' claim 1 as such halide does not constitute a halogen free alkylating agent.

For at least these reasons, it is Applicants' courteous position that the cited article does not make obvious Applicants' claimed invention. In consequence, Applicants respectfully request reconsideration and withdrawal of the 35 USC § 103 rejection.

Double Patenting

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Claims 1-14 stand rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claims 1-41 of US Patent 6,359,171 and claims 1-37 of US Patent No. 6,278,012. Attached herewith are terminal disclaimers directed to the above referenced patents.

Power of Attorney

The Office suggests the submission of a new power of attorney. Attached herewith is an Associate Power of Attorney.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,



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